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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/650,124	08/27/2003	Steven R. Reznick	03073	5523

7590
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EXAMINER

ALEXANDER, LYLE

ART UNIT

PAPER NUMBER

1797

MAIL DATE

DELIVERY MODE

10/09/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/650,124

Applicant(s)

REZNEK ET AL.

Examiner

LYLE A. ALEXANDER

Art Unit

1797

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 7-12, 14, 16-25, 69 and 70 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 7-12, 14, 16-25 and 69-70 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 69-70 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. It is not clear the original specification teaches the claimed "... property value for any physical phenomenon ...". The original specification has been consulted and the only reference to "...physical phenomenon ..." was in paragraphs [0022],[0030] and [0031]. However, there was no teaching of "... property value for any physical phenomenon ...". Clarification could be achieved by identifying the appropriate portion of the specification that supports these limitations.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 69-70 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claim is not clear what steps are intended by "after the effects of the morphology have been removed". Additionally, it is not clear what is intended by "... property value for any physical phenomenon ...".

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 7-12, 14, 16-25 and 69-70 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Mansky (US 2003/0097871).

Mansky teach in paragraph [0006] a method for screening an array of sample materials for a desired specific property. Each sample is subjected to one or more forces and the response to the forces is monitored and correlated to each sample materials. Paragraphs [0015-0021] teach identifying each sample by a tag and subjecting the samples to forces such as viscosity, surface tension and interfacial tensions. The Office has read these teachings on the claimed "identifying a product specification ... providing said particulate material ... measuring and obtaining at least one interfacial property ...". Paragraphs [0055] and [0058] teach the material can be either silica or carbon black respectively which is identical to the claimed materials. The Office has read the taught "**desired specific property**" on the claimed " ... *value on a product specification sheet, ... etc.*".

New claim 69 is identical in scope to original claim 1 and adds limitations that the interfacial property is a measurement of at least one physical property of the material. The Office maintains Mansky teaches in paragraphs [0015-0021] identifying the physical properties relating to viscosity, surface tension and interfacial tensions which are indistinguishable from the instant claims.

Response to Arguments

Applicant's arguments filed 7/2/09 have been fully considered but they are not persuasive.

Applicants' remarks concerning the 35 USC 112 1st paragraph rejection in the 1/12/09 Office action were convincing and that rejection has been vacated. However, in light of the 7/2/09 amendments a new 35 USC 112 1st paragraph rejection have been made.

Applicants' traverse the 35 USC 112 2nd paragraph rejections and state that one having ordinary skill in the art would have understood the language of claim 69. The Office maintains it is not clear what method steps are performed to accomplish the claimed removal of the "effects of morphology" and the rejections of record are proper.

Applicants traverse 35 USC 102 rejections over Mansky on the basis this reference is directed to binary code tagging and is not relevant to the instant claims. The instant claim language is sufficiently broad that it has been properly read on Mansky, who teaches all of the claimed steps as elaborated in the above rejections. Additionally, the instant claim language is open (e.g. comprising) and does not exclude any additional steps taught by Mansky.

Applicants direct the Office to "Example 2" on page 21-22 of the original specification to assist the Office in better understanding the invention. The Office understands samples "A"- "E" all are within 96% of the "max DBP" value but vary more widely with other tests. Applicants state the specification teaches that some different analysis techniques give different results on the same set of sample whereas other

techniques could give the same result on the same set of samples. It seems that Applicant is stating multiple test should be performed and checked if the same results are achieved. It is not clear how one having ordinary skill in the art would select these different test to be compared. However, the pending claims only require a single analysis and these remarks are not commensurate in scope with the pending claims.

Applicants state Mansky fail to teach a method of screening and does not detect surface or interfacial tension. The Office maintains Mansky clearly teaches these methods as described in the above rejections.

1. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LYLE A. ALEXANDER whose telephone number is (571)272-1254. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Lyle A Alexander/

Primary Examiner, Art Unit 1797